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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910

7590 08/09/2010

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EXAMINER	
HANG, VU B	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
08/09/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/955,963	SUMIYAMA ET AL.	
	Examiner	Art Unit	
	Vu B. Hang	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,8-12 and 16-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8-12 and 16-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the communication filed on 06/04/2010.
- The amendments received on 06/04/2010 have been entered and made of record.
- Claims 1-4, 8-12 and 16-26 are pending in the application.

Response to Arguments

1. Applicant's arguments filed on 06/04/2010, with respect to the amended independent claims and the previously cited prior art references, have been fully considered and are persuasive. Therefore, the previous rejections of Claims 1-4, 8-12 and 16-26 have been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Abdel-Mottaleb et al. (US Patent 5,915,038).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 8-11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Abdel-Mottaleb et al. (US Patent 5,915,038).

4. Regarding **Claims 1, 17 and 19**, Takahashi discloses an image forming apparatus connected to a memory-incorporating apparatus having an image memory via network (see Fig.1

(11,12,13) and Col.8, Line 64 – Col.9, Line 8), comprising: an input device for receiving image data (see Fig.1 (11), Fig.2 (26), Col.9, Line 48 – Col.10, Line 7 and Col.10, Line 43-52); a transfer portion for transferring the image received by the input device to the memory-incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56-65); a reception portion for receiving the image data transferred from the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Col.12, Line 26-42) {Note: Copy machine 11 of figure 11 receives an image stored at server 12 upon a user request.}; a printing device for forming an image (see Fig.1 (11), Fig.2 (27), Col.10, Line 8-25 and Col.10, Line 43-52); and a user interface display for displaying a plurality of image processing function keys (see Fig.3 (23c) and Col.9, Line 24-33), including a first key to accept a data transfer instruction to transfer the image data received by the input device to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65) {Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is performed while a copy of the image data is sent to server 12 as a backup file to be archived.} and a second key to accept a start instruction to form the image data received by the input device (see Fig.3 (23c), Col.10, Line 8-25 and Col.11, Line 35-42) {Note: The printer key from figure 3 enables the printing of the image data.}, wherein when the first key is pressed, the input device receives the image data and transfers the image to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65) and when the second key is pressed, the printing device forms an image based on the image data received by the input device (see Fig.3 (23c), Col.10, Line 8-25 and Col.11, Line 35-42).

5. Takahashi fails to disclose wherein the user interface displays a third key to accept a reread instruction to reread the image data transferred from the memory-incorporating apparatus, wherein the third key is displayed after the image data is transferred to the memory-incorporating apparatus, and wherein when the third key is pressed, the reception portion receives the image data transferred from the memory-incorporating apparatus and the printing device forms an image based on the received image data. Takahashi, however, teaches receiving and printing the image data stored at the memory-incorporating apparatus upon a user request (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Col.12, Line 26-42). Abdel-Mottaleb teaches displaying a query image as an index key for selecting and retrieving an image from a remote storage device (see Fig.2 (200,210), Fig.3 (14,16,22), Fig.10 (40), Col.5, Line 47-54, Col.6, Line 31-48 and Col.13, Line 29-39), wherein when the query image is selected, an image identified by the selected query image is retrieved from a remote storage device for display (see Fig.2 (200,210), Fig.3 (14,16,22,32) and Col.8, Line 11-26). The query image displayed at the user interface functions as an index key to identify and retrieve an image stored at the remote storage device for display.

6. Takahashi and Abdel-Mottaleb are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to a user interface display a third key to accept a reread instruction to reread the image data transferred from the memory-incorporating apparatus, wherein when the third key is pressed, the reception portion receives the image data transferred from the memory-incorporating apparatus and the printing device forms an image based on the received image data. The motivation would be to retrieve and print an image that is stored at a

remote storage device. The third key would identify and retrieve the stored image data from the remote storage device for printing. It is also obvious for one skilled in the art to display the third key on the user interface display after the image data is transferred to the memory-incorporating apparatus. The motivation would be to identify and retrieve the stored image data from the remote storage device when a user decides to print the stored image.

7. Regarding **Claims 2 and 10**, Takahashi further discloses a retrieval portion for retrieving the memory-incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56-65), wherein the retrieval portion retrieves the memory-incorporating apparatus when the first key is pressed (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65) {Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is performed while a copy of the image data is sent to server 12 as a backup file to be archived.}

8. Regarding **Claims 3 and 11**, Takahashi further discloses wherein when the retrieval portion identifies the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25) and Col.12, Line 2-12), the transfer portion transfers the image data received by the input device to the memory-incorporating apparatus identified by the retrieval portion (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56-65).

9. Regarding **Claims 8 and 16**, the rationale provided for the rejection of Claim 1 is incorporated herein.

10. Regarding **Claims 9, 18 and 20**, Takahashi discloses an image forming apparatus connected to a memory-incorporating apparatus having an image memory via network (see Fig.1 (11,12,13) and Col.8, Line 64 – Col.9, Line 8), comprising: a reading device for creating image

data by reading an image document (see Fig.1 (11), Fig.2 (26), Col.9, Line 48 – Col.10, Line 7 and Col.10, Line 43-52); a printing device for forming an image (see Fig.1 (11), Fig.2 (27), Col.10, Line 8-25 and Col.10, Line 43-52); a transfer portion for transferring the image data created by the reading device to the memory-incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56-65); a reception portion for receiving the image data transferred from the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Col.12, Line 26-42) {Note: Copy machine 11 of figure 11 receives an image stored at server 12 upon a user request.};); and a user interface display for displaying a plurality of image processing function keys (see Fig.3 (23c) and Col.9, Line 24-33), including a first key to accept a data transfer instruction to transfer the image data received by the input device to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65) {Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is performed while a copy of the image data is sent to server 12 as a backup file to be archived.} and a second key to accept a start instruction to form the image data received by the input device (see Fig.3 (23c), Col.10, Line 8-25 and Col.11, Line 35-42) {Note: The printer key from figure 3 enables the printing of the image data.}, wherein when the first key is pressed, the input device receives the image data and transfers the image to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65) and when the second key is pressed, the printing device forms an image based on the image data received by the input device (see Fig.3 (23c), Col.10, Line 8-25 and Col.11, Line 35-42).

11. Takahashi fails to disclose wherein the user interface displays a third key to accept a reread instruction to reread the image data transferred from the memory-incorporating apparatus,

wherein the third key is displayed after the image data is transferred to the memory-incorporating apparatus, and wherein when the third key is pressed, the reception portion receives the image data transferred from the memory-incorporating apparatus and the printing device forms an image based on the received image data. Takahashi, however, teaches receiving and printing the image data stored at the memory-incorporating apparatus upon a user request (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Col.12, Line 26-42). Abdel-Mottaleb teaches displaying a query image as an index key for selecting and retrieving an image from a remote storage device (see Fig.2 (200,210), Fig.3 (14,16,22), Fig.10 (40), Col.5, Line 47-54, Col.6, Line 31-48 and Col.13, Line 29-39), wherein when the query image is selected, an image identified by the selected query image is retrieved from a remote storage device for display (see Fig.2 (200,210), Fig.3 (14,16,22,32) and Col.8, Line 11-26). The query image displayed at the user interface functions as an index key to identify and retrieve an image stored at the remote storage device for display.

12. Takahashi and Abdel-Mottaleb are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to a user interface display a third key to accept a reread instruction to reread the image data transferred from the memory-incorporating apparatus, wherein when the third key is pressed, the reception portion receives the image data transferred from the memory-incorporating apparatus and the printing device forms an image based on the received image data. The motivation would be to retrieve and print an image that is stored at a remote storage device. The third key would identify and retrieve the stored image data from the remote storage device for printing. It is also obvious for one skilled in the art to display the third

key on the user interface display after the image data is transferred to the memory-incorporating apparatus. The motivation would be to identify and retrieve the stored image data from the remote storage device when a user decides to print the stored image.

13. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Abdel-Mottaleb et al. (US Patent 5,915,038), and in further view of Nishiyama et al. (US Patent 6,067,168).

Regarding **Claims 4 and 12**, Takahashi and Abdel-Mottaleb teach the image forming apparatus of Claims 1 and 9 but they fail to disclose a warning device for informing a user that the retrieval portion cannot identify a memory-incorporating apparatus. Takahashi, however, teaches using a graphical user interface for communicating with the memory-incorporating apparatus (see Fig.3 and Col.9, Line 24-33). Nishiyama discloses an image forming apparatus that includes a warning device for displaying a message informing a user the presence of an external memory- incorporating device (see Fig.16 (S37), Fig.17a (121a) and Col. 18, Line 43-49).

14. Takahashi, Abdel-Mottaleb and Nishiyama are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to Takahashi's image forming apparatus a warning device for informing a user that the retrieval portion cannot identify a memory- incorporating apparatus. The motivation would be to notify a user that an external memory- incorporating device is not present for image transferring.

15. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B 1) in view of Abdel-Mottaleb et al. (US Patent 5,915,038), and in further view of Anai (US Patent 5,663,800).

16. Regarding **Claim 21**, Takahasi and Abdel-Mottaleb teach the image forming apparatus as described in Claim 1 but they fail to disclose wherein the image forming apparatus does not have an image memory. Takahashi, however, discloses transferring the image data to an external memory-incorporated device for data storage and backup (see Fig.1 (11,13,16) and Col.8, Line 61 - Col.9, Line 8), and teaches that retrieving the stored image data from the external memory-incorporated device whenever required enables easy retrieval of image data without requiring complicated operations (see Col.2, Line 19-36). Anai discloses an image forming apparatus that does not have an image memory (see Fig.3 and Col.2, Line 7-22), and teaches that a no-memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus without complicated image data conversions (see Col.2, Line 7-22).

17. Takahashi, Abdel-Mottaleb and Anai are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to use an image forming apparatus that does not have an image memory. The motivation would be to increase the image processing efficiency. The a non- memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus, without complicated image data conversions (as taught by Anai).

18. Regarding **Claims 22-26**, the rationale provided for the rejection of Claim 21 is incorporated herein.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625